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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,974	02/25/2002	Christopher Bentley Shumate	AUROBIO.013CC1	8118

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EXAMINER	
HANDY, DWAYNE K	

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/082,974	SHUMATE ET AL.	
	Examiner	Art Unit	
	Dwayne K Handy	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 31 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of U.S. Patent No. 6,372,185. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 26 of U.S. Patent No. 6,372,185 teaches every element of instant claim 31 except for the number of tips in the liquid handler. It would be obvious to one of ordinary skill in the art, however, to provide a greater number of dispensing tips in order to dispense materials to a greater number of wells. Since multiwell plates use a standard number of wells in multiples of 48 or 96, the use of 384 tips or more would be obvious to one of ordinary skill in the art.

Inventorship

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lebl. et al. (6,045,755) in view of Pfost et al. (5,104,621). Lebl teaches a system for combinatorial chemistry that includes various integrated workstations and includes robotic elements, reaction vessels and dispensing elements. The fluid dispensing/aspirating workstation is best shown in Figure 15 and described in column 31, line 7 through column 32, line 28. Bottom plate (402) carries an array of 96 needles (412) that are arranged in an 8X12 array. Lebl also teaches that the bottom plate (402) containing the needles may be replaced with other plates having different needle arrays. The workstation includes a movable platform for holding a reaction array (414). The movable platform moves only in one direction however. Lebl, then, teaches at least on liquid handler comprising 48 or more tips and a positioner, but does NOT teach a positioner capable of moving in BOTH the X and Y directions. Pfost et al. (5,104,621) teaches an automated analytical workstation. The workstation is best shown in Figure 1 and includes a table (#28) for supporting a microtiter plate. The table is movable in the X-Y plane and is used to align the microtiter plate with dispensing and analytical modules. It would have been obvious to one of ordinary skill in the art to combine the motorized, movable table of Pfost with the workstation of Lebl to obtain a dispenser that has a positioner that moves in two dimensions. One would add the table of Pfost to provide an additional means of aligning the dispensing means with the reaction wells to prevent spills or improper loading of the wells. As for the limitation of the table moving at an accuracy within 0.09 mm (cl. 28), the accuracy of the table movement could easily be achieved through the control of the computer operating the device. Both Lebl and

Pfost teach computer control of their systems. As for the limitation of having more than 384 dispensing tips, it would have been obvious to provide a greater number of dispensing tips in order to dispense materials to a greater number of wells. Since multiwell plates use a standard number of wells in multiples of 48 or 96, the use of 384 tips or more would be obvious to one of ordinary skill in the art.

Conclusion

6. The Examiner did not make this action Final since the USPTO erred in not entering the Preliminary Amendment submitted 2/25/02 and then resubmitted by applicant on 4/15/2004.

7. The Examiner also wishes to note for the record that during examination of the new claim 31, the Examiner wondered if a typographical error was made by applicant with the claiming of a liquid handler comprised of "48 or more, ***but not less than*** 384 tips...". Taken literally this limitation claims a liquid handler of 384 or more tips so this is how the Examiner treated the claim and an objection to the claim was not made. The Examiner reminds applicant that if it is indeed a typographical error, then amending the claim to read "but not more than 384" would lead to a Double Patenting rejection under U.S.C 101.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
May 4, 2004

Jill Warden
Supervisory Patent Examiner
Technology Center 1700